

REMARKS

Claims 1, 3-5 and 15-46 are currently pending. Claims 15-46 are withdrawn from consideration as being directed to a non-elected invention. In the non-final Office Action dated August 16, 2007, the Examiner made the following disposition:

- A.) Commented on the claims.
- B.) Rejected claims 1 and 3-5 under 35 U.S.C. §112, first paragraph.
- C.) Rejected claims 1 and 3-5 under 35 U.S.C. §112, second paragraph.
- D.) Rejected claims 1 and 3-5 under 35 U.S.C. §102(b) or §103(a) in view of *Hayashi, et al.* (*JP 10-334915*) ("*Hayashi*").

Applicants respectfully traverse the rejections and address the Examiner's disposition below.

- A.) Comment on the claims:

Claims 1 and 3-5 each have been amended as per the Examiner's request to clarify the claim language. Applicants note that claims 1 and 3-5 do not recite product-by-process limitations.

- B.) Rejection of claims 1 and 3-5 under 35 U.S.C. §112, first paragraph:

Claims 1 and 3-5 each have been amended as per the Examiner's request to overcome the rejection.

Applicants respectfully submit the rejection has been overcome and request that it be withdrawn.

C.) Rejection of claims 1 and 3-5 under 35 U.S.C. §112, second paragraph:

Claims 1 and 3-5 each have been amended as per the Examiner's request to overcome the rejection.

Applicants note that claims 1 and 3-5 do not recite product-by-process limitations.

The Examiner comments that "it is unclear how the graphite material undergoes a "weight reduction" ". Office Action of 8/16/07, page 4. Applicants note that claims 1 and 3-5, as amended, do not claim a process step of performing a weight reduction and do not recite a product-by-process limitation. Instead, claims 1 and 3-5 recite that the non-graphite material exhibits a particular property. Specifically, the non-graphite material exhibits a property of a weight reduction as measured by a differentiation of a thermogravimetric curve as obtained by thermogravimetric analysis in an airflow of at least 5% and at most 40%.

Applicants respectfully submit the rejection has been overcome and request that it be withdrawn.

D.) Rejection of claims 1 and 3-5 under 35 U.S.C. §102(b) or §103(a) in view of *Hayashi, et al. (JP 10-334915)*("Hayashi"):

Applicants respectfully disagree with the rejection.

Independent claims 1 and 3-5 each claim subject matter relating to a non-aqueous electrolyte secondary battery comprising a positive electrode, a negative electrode and a non-aqueous electrolyte. The negative electrode contains graphite containing material that includes graphite and a material other than graphite. The graphite containing material exhibits a weight reduction of the graphite material as measured by a differentiation of a thermogravimetric curve as obtained by thermogravimetric analysis in an airflow of at least 5% and at most 40%.

Applicants note that claims 1 and 3-5 do not recite product-by-process limitations. Instead, claims 1 and 3-5 recite that the non-graphite material exhibits a particular property. Specifically, the non-graphite material exhibits a property of a weight reduction as measured by a differentiation of a thermogravimetric curve as obtained by thermogravimetric analysis in an airflow of at least 5% and at most 40%.

This is clearly unlike *Hayashi*, which fails to disclose or suggest a non-graphite material that exhibits a property of a weight reduction as measured by a differentiation of a thermogravimetric curve as obtained by thermogravimetric analysis in an airflow of at least 5%

and at most 40%. This subject matter is simply not addressed in *Hayashi*. Accordingly, *Hayashi* could not teach or even suggest this claimed subject matter.

Therefore, *Hayashi* fails to disclose or suggest claim 1 and 3-5.

Applicants respectfully submit the rejection has been overcome and request that it be withdrawn.

CONCLUSION

Applicants respectfully requests withdrawal of the rejections and believe that the claims as presented represent allowable subject matter.

Applicants believe there is no fee due at this time. However, the Commissioner is hereby authorized to deduct any deficiency or credit any overpayment to Deposit Account No. 19-3140.

Respectfully submitted,

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